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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,265	07/08/2003	Helge Otto Friedrich Sahl	078715.00001	2419

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EXAMINER

SAYALA, CHHAYA D

ART UNIT PAPER NUMBER

1761

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/617,265

Applicant(s)

FRIEDRICH SAHL, HELGE OTTO

Examiner

C. SAYALA

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-4 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The insertion of "select" instead of "valuable" introduces new matter into the claims because the specification does not describe "select" materials and what this term stands for.

At page 8, paragraph 2, the specification describes what is meant by the terms "organic and non-organic waste". Therefore, applicant must point out where the terms "organic and inorganic" is described or defined.

In claim 4, the limitation which recites that "wherein all the steps of the method are completed within a 24 hour period" could not be found. What was found in the specification at page 14, first paragraph, was this: that the bioconversion was typically between 3-6 hours and when whole waste streams were treated the time increased to between 6-24 hours. "All the steps" are not related to bioconversion alone.

See MPEP 714.02 and 2163.06 which states that "Applicant should specifically point out support for any amendments made to the disclosure". See also 37 CFR

1.121(f). Upon a cursory review, basis for these amendments could not be found and when applicant points out where the basis of this change to the claims can be found, this rejection will be withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4, 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

“select” in claim 1, line 4 and in claim 6, is of indeterminate scope and fails to define the metes and bounds of the materials that it ought to define.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisk (US Patent 3847803) in view of Schmidt (US Patent 6197081) and JP 54067073 and BE 879840.

Fisk teaches the following steps: providing the solid waste for treatment, grinding unsorted waste into particles, adding sewage sludge, sterilizing the waste with steam. Fisk does not teach transferring the sewage sludge into a rotary drum for mixing.

Schmidt teaches a reactor vessel, which enables the sterilization step at elevated pressure and temperature for 30 minutes, which is depressurized after the step (see col. 11). JP '073 and BE '840 both teach that the use of a rotary drum to blend waste materials was known in the art.

It would have been obvious to one of ordinary skill in the art to use Schmidt's teaching of the reactor vessel in the sterilizing step of Fisk and to use a rotary drum to blend the waste and sewage sludge, as this was already known in the art at the time the invention was made.

Fisk teaches separating biodegradable and non-biodegradables *after* the sterilization step. Fisk does not teach that organic waste and inorganic waste or non-organic waste was ever separated. Therefore the composting step in Fisk includes both types of waste. If applicant converts both inorganic (non-organic) and organic waste in a whole waste stream, by bacterial/enzyme action, then Fisk et al. has done the same and would have achieved the same end product. Whether uncomposted material or non-organic material that would not be composted, is separated or removed is a matter of personal choice because one of ordinary skill in the art would have known that such material does not contribute to being useful as a compost material.

The patent does not teach that all the method steps were completed in a 24-hour period. However, it would have been obvious to one of ordinary skill in the art at the

time the invention was made that the time taken to achieve the conversion of the wastes to the desired end product is a function of the various reagents, amounts of thermoactivators, enzymes, digestors, etc. used for the bioconversion, and to optimize such amounts and reagents so that the desired time for the conversion would have been achieved would have been within the ambit of ordinary skill.

### ***Response to Arguments***

Applicant's arguments filed 9/17/2004 have been fully considered but they are not persuasive.

Applicant has replaced "valuable" with "select" and urges that the rejection under 35 USC 112 has been overcome. However, the specification at page 10 states: The first step in the process is to automatically extract valuable materials from the waste stream. For example, materials such as aluminum cans, can be extracted depending upon their economic value. At page 15, lines 7-8, the valuable materials are described as "such as aluminum and/or tin". At page 4, the specification states that "None of the prior methods discloses a system for effectively treating combinations of all waste, or selective waste streams of both organic and non-organic waste, or an entire municipal waste stream."

It is well established that claims in an application are to be given their broadest reasonable interpretation, taking into account the written description found in the

specification. In re Hyatt, 211 F.3d 1367, 1372, 54USPQ2d 1664, 1667 (Fed Cir. 2000).

Applicant's recitation of extracting "valuable" or "select" materials from the solid waste reads on prior art methods of selectively sorting municipal waste by analyzing and removing plastics, glass, batteries, aluminum, iron, etc. See for instance col. 4, lines 1-10, US Patent 5441552 or col. 6, line 43 to col. 7, line 8 in US Patent 5744041.

Therefore, even though applicant states that the entire municipal waste stream is used in his invention (see specification at page 4, last lines of second paragraph), as opposed to prior art, it appears that by removing "selected" materials, applicant is doing the same thing as prior art, unless these materials are properly defined or identified by describing what these terms "valuable" or "select" represent.

As for applicant's remarks on page 7 of his response, that Fisk does not show a method that is completed in 24 hours and that he teaches the separation of biodegradables from non-biodegradables. See col. 2, lines 43-57, wherein Fisk teaches that the biodegradables while still mixed with non-biodegradables solids are ground together and undergoes anaerobic predigestion.. If applicant converts both inorganic (non-organic) and organic waste in a whole waste stream, by bacterial/enzyme action, then Fisk et al. has done the same since the patentee also uses waste that has been unsorted (col. 1, lines 52-55), and would have achieved the same end product. In any event, the non-organic waste would not be degraded or composted, just as in Fisk, and one of ordinary skill in the art at the time the invention was made would not expect the non-organics to be composted, which is the method claimed herein, and removal of the non-organic or the retaining of it would not be of any patentable moment because in the

one case it would be removed and the other it would be inert in the composted composition or end-product. Claim 4 preamble reads "A method of converting municipal solid waste into a useful compost material..." Retaining inert material, or uncomposted material in the Fisk method instead of removing it, does not add any patentable weight to the claimed method.

Applicant's claiming that the time for all method steps being conducted is a 24-hour time period would also have been obvious to the skilled person, because the skilled person would know that the time taken would depend on the volume of waste, the strength and amounts of thermoactivators/enzymes used and other such parameters. To control such parameters during a composting process is within the ambit of the routineer. One of ordinary skill in the art is held accountable not only for the specific teachings of references, but also for the inferences which those skilled in the art may reasonably be expected to draw. In re Hoeschele, 160 USPQ 809, 811, (CCPA 1969)

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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